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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,469	01/18/2006	Thilo Dollase	101769-310-WCG	3249
27386	7590	03/17/2008		
NORRIS, MCLAUGHLIN & MARCUS, P.A.			EXAMINER	
875 THIRD AVE			CHANG, VICTOR S	
18TH FLOOR				
NEW YORK, NY 10022			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			03/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,469

Applicant(s)

DOLLASE ET AL.

Examiner

Victor S. Chang

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Introduction

1. Applicants' amendments and remarks filed on 2/15/2008 have been entered. Claims 1, 5, 9 and 10 have been amended. Claims 1, 2, 4-6 and 8-11 are active. The identifiers of withdrawn claims 3 and 7 are incorrect. Correction is required in the next reply to avoid notice of non-responsive amendment.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Rejections Based on Prior Art

4. Claims 1, 2, 6, 8, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-025460 [machine translation], and evidenced by applicants' admission.

JP '460 relates to an acrylic pressure-sensitive adhesive composition. The composition comprises block copolymer represented by the formula (A-B)_a-A, wherein A is a vinyl (co)polymer; B is a (co)polymer of a 1-12C alkyl (meth)acrylate; a = 1 to 10. For example, A-B-A block copolymer obtained by copolymerizing n-butyl acrylate polymer blocks with methyl methacrylate block [abstract]. The adhesive can be used to form a pressure sensitive adhesive sheet, etc., on one side or both sides of a base material, such as paper, etc. [0058 and 0060]. Regarding the glass transition temperatures and immiscibility of the polymer blocks, since

applicants have admitted that useful monomers of block P(A) include acrylic esters with alkyl groups having 4 to 14 carbon atoms (e.g., n-butyl acrylate), etc. [specification, page 15].

Further, useful monomers of block P(B) include methyl methacrylate, etc. [specification, page 16]. The glass transition temperatures and miscibility of the A-B-A block copolymer (n-butyl acrylate polymer blocks and methyl methacrylate polymer block) taught by JP '460 are deemed to be inherent properties of the same chemistry.

For claims 1, 2 and 8, JP '460 anticipates all the claimed features.

For claim 6, the use limitation "within a pad of said sheets, comprising at least two of said pressure-sensitive adhesive sheets lying one atop another" has not been given any patentable weight, because the statements of intended use do not serve to distinguish structure over the prior art. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974).

For claim 9, since JP '460 anticipates the block copolymers as claimed, their refractive indices are deemed to be inherent properties of the same chemistry.

For claim 11, the paper support of an adhesive sheet product inherently has a commercially acceptable color.

5. Claims 4, 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-025460 [machine translation].

The teachings of JP '460 are again relied upon as set forth above.

For claims 4, 5 and 10, JP '460 is silent about the use of release layer and adhesion promoting primer layer. Absence of any supposed errors being pointed out by applicants' response, the Official notice in the prior Office action "these layers are common and well known" is now taken as admitted prior art. It would have been obvious to one of ordinary skill

in the art to incorporate that layers in adhesive sheets formed from the adhesives of JP '460, motivated by the desire to improve the release property of individual adhesive sheets from a multilayered adhesive pad, or unwind an adhesive strip from an adhesive tape roll; and to enhance the adhesion between the adhesive layer and support, respectively.

Response to Arguments

6. Applicants argue at Remarks page 9 that nothing in JP '460 suggests the glass transition temperatures and the miscibility of the polymer blocks. However, they are deemed to be inherent properties of the same chemistry of the claimed invention.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794